IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	: Richard Rodriquez-Val et al.	Art Unit	: 2171
Serial No.	: 10/032,006	Examiner	: Sana A. Al-Hashemi
Filed	: December 31, 2001		
Title	: AUTOMATIC VERIFICATION OF A USER		

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

<u>BRIEF ON APPEAL</u>

(1)   Real Party in Interest

The real party in interest is America Online, Incorporated.

(2)   Related Appeals and Interferences

Applicant filed a pre-appeal brief request for review on December 19, 2005 pursuant to United States Patent and Trademark Office OG Notices: 12 July 2005 – New Pre-Appeal Brief Conference Pilot Program. Consideration of the pre-appeal brief, however, did not resolve all appealable issues. A copy of the decision rendered by the Pre-Appeal Board is enclosed in an appendix as required by 37 CFR 41.37(c)(1)(x).

(3)   Status of Claims

<u>Rejected Claims</u>

23-33, 35, and 36.

<u>Canceled Claims</u>

1-22, 34, 37-47.

<u>Claims Appealed</u>

23-33, 35, and 36.

(4)   Status of Amendments

The amendment filed on September 19, 2005, in response to the final Office Action was not entered by the advisory action dated September 29, 2005.

(5)   Summary of Claimed Subject Matter

Independent claims 23 and 35 are directed to a method and a system, respectively, for enabling a billing configuration. Specifically, the subject matter of independent claims 23 and 35 may be employed to allow, for example, a user to register with Internet Service Provider ("ISP") and elect to have the ISP charges billed to his or her telephone number. Application, page 8, lines 16-17. The system receives first data regarding a communications characteristic. Application, page 9, lines 7-10 (stating that the communications characteristic may include Automatic Number Identification (ANI) data generated by user's modem that dials into ISP's modem pool). The system retrieves second data indicative of a frequency of usage related to the communications characteristic. Application, page 14, lines 10-13 and FIG. 3. The system also retrieves third data indicative of a frequency of usage threshold and compares the second data to the third data. Application, page 14, lines 10-13 and FIG. 3 (stating "the number of accounts already associated with [the] telephone number is determined and evaluated to determine whether it exceeds a threshold (step 325) (e.g., too many accounts associated with on telephone number)"). Based on results of the comparison between the second data and the third data, the system enables a billing configuration. Application, page 14, lines 14-15 (stating "[i]f the received data passes all three tests, the user is allowed to use telephone billing (step 330)").

Independent claims 29 and 36 are directed to a method and a system, respectively, for enabling a user configuration. The system receives a data regarding communications characteristic. Application, page 9, lines 7-8. The formatting characteristic of the received data is identified and is compared against a format criteria. Application, page 14, lines 2-3 and FIG. 3 (stating "the format of the received data is checked (step 305) to determine whether a full set of telephone number data was received (i.e., ten digits) and whether the telephone number contains letters instead of all numbers"). Based on the results of the comparison between the formatting characteristic and the format criteria, a user configuration may be enabled. Application, page 14, lines 14-15 (stating "[i]f the user passes all three tests, the user is allowed to use telephone billing (step (330)").

(6)   Grounds of Rejection

A. Whether claims 23-28 and 35 are unpatentable under 35 U.S.C. § 103 over U.S. Patent Number 6,820,802 ("Biggar") in view of U.S. Patent Number 6,807,574 ("Partovi").

B. Whether claims 29-33 and 36 are unpatentable under 35 U.S.C. § 102(e) over U.S. Patent Number 5,699,514 ("Durinovic-Johri").

(7)   Argument

Rejection under 35 U.S.C. 103

1. Claims 23-28.

The Final Office Action has failed to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met:

> First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

MPEP § 2143. Applicant respectfully asserts Biggar and Partovi, either alone or in combination, fail to teach or describe all the features of independent claim 23. Specifically, Biggar and Partovi, either alone or in combination, fail to teach or describe "retrieving second data indicative of a frequency of usage related to the communications characteristic and retrieving third data indicative of a frequency of usage threshold," as recited in claim 23. Furthermore, Biggar and Partovi, either alone or in combination, fail to teach or describe "comparing the second data to [and] the third data; and based on results of the comparison between the second data and the third data, enabling a billing configuration," as recited in claim 23 (emphasis added).

Specifically, according to claim 23, first data regarding a communications characteristic, second data indicative of a frequency of usage related to the communications characteristic, and third data indicative of a frequency of usage threshold are retrieved. The second data is compared to the third data, and a billing configuration is enabled based on results of the comparison between the second data and the third data.

To illustrate with reference to a non-limiting example provided in the specification with respect to FIG. 3, "the number of accounts already associated with [the] telephone number is determined and evaluated to determine whether it exceeds a threshold (step 325) (i.e. too many accounts associated with one telephone number)." Application, page 14, lines 10-13. Based on the results of this comparison, the user is allowed to use telephone billing (step 330). Application, page 14, lines 14-15.

Biggar relates to "activating a card or device (such as, for example, a credit card, a debit card or a cellular phone) through a computer network, and more particularly, through a site on a global computer network such as, for example, the internet." Col. 1, lines 11-16. Specifically, the Biggar system enables "online account activation between a consumer having an account with a service provider." Abstract. The consumer provides information identifying the account to be activated, such as a credit card account, to the service provider. Col. 4, lines 35-45. The service provider retrieves locally stored information identifying the account and compares the information received from the consumer to the locally stored information. Col. 4, lines 46-54. Alternatively or additionally, the service provider may retrieve information from an external data source when processing the information received from the consumer. Col. 4, lines 55-59. Depending on whether the information received from the consumer matches the locally stored information or the information received from the external data source, the account may be activated. Col. 5, lines 28-55.

As such, Biggar fails to teach or describe "retrieving second data indicative of <u>a frequency of usage</u> related to the communications characteristic; retrieving third data indicative of <u>a frequency of usage threshold;</u> comparing the second data to and the third data; and based on results of the comparison between the second data and the third data, enabling <u>a billing configuration</u>," as recited in claim 23.

A. Biggar fails to describe or suggest "retrieving second data indicative of <u>a frequency of usage</u> related to the communications characteristic and retrieving third data indicative of <u>a frequency of usage threshold,</u>" as recited in claim 23.

The Final Office Action asserts column 4, lines 46-59 of Biggar shows "retrieving second data indicative of <u>a frequency of usage</u> related to the communications characteristic and

retrieving third data indicative of <u>a frequency of usage threshold</u>," as recited in claim 23. <u>See</u> Final Office Action at page 3, lines 3-6. Applicant disagrees. In column 4, lines 21-59 Biggar actually describes a process for allowing a cardholder to access a specific web site via Internet to activate his or her card. Col. 4, lines 21-31. Biggar states "[w]hen the cardholder accesses this site, the cardholder is prompted to provide predetermined card information to the site, such as, for example, the cardholder's name, any predetermined identifiers printed on the card (such as alphanumeric text)." Col. 4, lines 32-48. After the cardholder submits this information to the web site a "second computing system… compares the predetermined card information against previously stored customer data." Col. 4, lines 48-51. Alternatively, Biggar describes "the second computing system can process the information by also communicating with [a] third computing system…to obtain any additional database information…corresponding to the cardholder or the card." Col. 4, lines 55-59. Subsequently, the second computing system "determines whether the cardholder-supplied card information matches the previously stored customer data in a database." Col. 4, line 66 – col. 5, line 1. As such, in this section, Biggar merely teaches a process for activating a card, without reference to frequency of usage information.

Accordingly, such recitations from Biggar do not teach or describe "retrieving second data indicative of <u>a frequency of usage</u> related to the communications characteristic and retrieving third data indicative of <u>a frequency of usage threshold</u>," as recited in claim 23.

The Advisory Action, at least implicitly, acknowledges that the cited section of Biggar in the Final Office Action do not teach or describe the above underlined features of claim 23 because the Advisory Action relies on entirely different sections of Biggar to show this feature. <u>See</u> Advisory Action, page 2, lines 5-10. Specifically, Advisory Action relies on column 3, lines 31-53 to show "retrieving second data indicative of <u>a frequency of usage</u> related to the communications characteristic," as recited in claim 23 and column 5, lines 56-64 and column 7, lines 12-23 to show "retrieving third data indicative of <u>a frequency of usage threshold</u>," as recited in claim 23. Applicant respectfully asserts that these sections of Biggar also fail to teach or describe "retrieving second data indicative of <u>a frequency of usage</u> related to the communications characteristic and retrieving third data indicative of <u>a frequency of usage threshold</u>," as recited in claim 23.

In column 3, lines 31-53, Biggar describers "[a] 'card' or 'account number,' as used herein, includes any device, code, or other identifier suitably configured to allow the consumer to interact or communicate with the system." Col. 3, lines 31-34. Relying on this section, the Advisory Action asserts that Biggar "discloses frequency of usage by allowing the user to enter the user ID and password that is a frequency of usage." Advisory Action, page 2, lines 5-6. Applicant disagrees with this assertion. Presuming *arguendo* that user ID and password may be considered communications characteristic data, Applicant notes that Biggar fails to teach receiving or otherwise using a frequency of usage related to that data. Otherwise said, disclosing entry by a user of his or her user ID and password is not a disclosure of receipt of the frequency that the user employs the user ID and password. Therefore, Applicant respectfully asserts that Biggar in this section fails to describe or suggest "retrieving second data indicative of a frequency of usage related to the communications characteristic," as recited in claim 23.

In column 5, lines 56-64 Biggar describes fraud processing rules which allow "the card provider to more accurately determine whether the card being activated belongs to the cardholder." Col. 5, lines 56-59. As such, this section of Biggar describes a process for identifying fraudulent activation attempts. Yet again, however, this section of Biggar fails to describe or suggest "retrieving third data indicative of a frequency of usage threshold," as recited in claim 23. In column 7, lines 12-23 Biggar describes an authentication process in which a computer system generates questions to a cardholder that wishes to actives his or her card to verify that the cardholder is the proper party possessing the card. As such, this section of Biggar also fails to describe or suggest "retrieving third data indicative of a frequency of usage threshold," as recited in claim 23.

B. Biggar fails to describe or suggest "based on results of the comparison between the second data and the third data, enabling a billing configuration," as recited in claim 23.

The Final Office Action relies upon column 5, lines 38-45 of Biggar to show "based on results of the comparison between the second data and the third data, enabling a billing configuration," as recited in claim 23. Applicant respectfully disagrees. In column 5, lines 38-45, Biggar describes that "if the card information does match the system data...the second computing system next determines whether the card is unavailable for processing, for example

by determining whether the card has already been activated and/or authorized for use." Col. 5, lines 38-43. Biggar further states that "[i]f the card was previously activated or authorized for use by the provider, the second computing system then displays a card already activated message to the cardholder." Col. 5, lines 43-46. As such, Biggar in this section refers to a <u>card activation</u>. Accordingly, Biggar fails to describer or suggest "based on results of the comparison between the second data and the third data, enabling <u>a billing configuration</u>," as recited in claim 23.

> *C. Partovi does not remedy the failure of Biggar to describe or suggest "a frequency of usage," "a frequency of usage threshold," and "a billing configuration," as recited in claim 23.*

Partovi relates to "technologies for identifying and registering users using telephone identifying information and personalizing the content presented to them using a profile selected using the telephone identifying information." Col. 1, lines 60-64. As such, Partovi does not remedy the failure of Biggar to describe or suggest "retrieving second data indicative of <u>a frequency of usage</u> related to the communications characteristic; retrieving third data indicative of <u>a frequency of usage threshold</u>; comparing the second data to and the third data; and based on results of the comparison between the second data and the third data, enabling <u>a billing configuration</u>," as recited in claim 23. Moreover, the Final Office Action does not rely on Partovi to teach <u>any</u> of the features of claim 23.

For the foregoing reasons, Biggar and Partovi, either alone or in combination, fail to describe or suggest all the features of claim 23. Thus, Applicant respectfully requests that the rejection of claim 23 along with its dependent claims to be reversed.

2. Claim 35.

Similar to claim 23, claim 35 recites a system in which second data indicative of a frequency of usage related to the communications characteristic and third data indicative of a frequency of usage threshold are retrieved, and the system enables a billing configuration based on results of the comparison between the second data and the third data. Accordingly, Applicant respectfully requests the rejection of claim 35 to be reversed for at least the reasons described above with respect to claim 23.

Rejection under U.S.C. 102(e)

1. Claims 29-33.

The Final Office Action has not established anticipation of independent claim 29. To establish anticipation, a single reference must disclose all of the claim elements. MPEP § 2131. Applicant respectfully asserts Durinovic-Johri fails to describe or suggest all the features of claim 29. Specifically, Durinovic-Johri fails to describe or suggest "identifying a formatting characteristic of the data received" and "comparing the formatting characteristic against a format criteria," as recited in claim 29.

Independent claim 29 recites a method for enabling a user configuration. The method includes "receiving data regarding a communication characteristic, identifying a formatting characteristic of the data received, comparing the formatting characteristic against a format criteria, and enabling a user configuration based on results of the comparison between the formatting characteristic and the format criteria."

To provide context that may be helpful in orienting with respect to the subject matter of claim 29, the specification describes the following example with respect to FIG. 3:

> the format of the received data is checked (step 305) to determine whether a full set of telephone number data was received (i.e., ten digits) and whether the telephone number contains letters instead of all numbers. If the received telephone number data is not formatted properly, it will be evaluated to determine whether it can be reformatted (e.g., substitute a number for a received letter) (step 310). The telephone number data will be reformatted where possible (step 315).

Application, page 14, lines 1-7. Based on the results of the comparison between the formatting characteristic of the telephone number and the format criteria, a user configuration (e.g., telephone billing) is enabled. Application, page 14, lines 14-15.

Durinovic-Johri describes an access control system that stores a primary code and a secondary code for each user that is authorized to access a resource (Durinovic-Johri, Abstract). The user may provide only the primary code to gain access to the resource when the user has submitted less than a first threshold number of invalid requests for access to the resource within a first threshold amount of time. An invalid request from the user is a request that includes an indication of the primary code that does not match an indication of the primary code that is

stored by the access control system. After the first threshold has been exceeded, the user may be required to provide both the primary and secondary codes to gain access to the resource. If the user provides indications of the primary and secondary codes that do not match the indications of the primary and secondary codes that are stored by the access control system more than a second threshold number of times within a second threshold amount of time, the user may be denied access to the resource for a particular amount of time. However, through its disclosure of the above process, Durinovic-Johri fails to describe or suggest "identifying a formatting characteristic of the data received" and "comparing the formatting characteristic against a format criteria," as recited in claim 29.

A. Durinovic-Johri fails to describe or suggest "identifying a formatting characteristic of the data received," as recited in claim 29.

The sections of Durinovic-Johri cited by the Final Office Action to describe "identifying a formatting characteristic of the data received," as recited in claim 29, actually describe determining whether to reset system state "based upon the time difference between the current time and the time at which the last failed access attempt occurred." Col. 4, lines 23-25. Therefore, the cited section of Durinovic-Johri does not describe or suggest that a formatting characteristic of the received data is identified, as alleged by the Final Office Action. In fact, the described determination of whether to reset system state does not depend on the received data or its format.

In response to Applicant's arguments in reply to Office Action dated March 1, 2005, the Final Office Action indicates that "the Durinovic-Johri discloses a typical format of records   · stored in a database represents information associated with a particular user requesting access Fig. 4, Col. 7, lines 21-25, Durinovic-Johri disclose the identifying the characteristic formatting." Final Office Action, page 6, lines 9-11. Applicant concedes that Durinovic-Johri describes a format of a database from which data is retrieved; however, it is clear that Durinovic-Johri nevertheless fails to describe or suggest identifying a formatting characteristic of received data. The format of the database that includes the received data is not a formatting characteristic of the received data itself. The format of the database identifies a location for the received data within the database, without indicating a formatting characteristic of the received data at the identified

location. Moreover, even overlooking the distinction between the format of a database that includes the received data and the formatting characteristics of the received data itself, Durinovic-Johri fails to describe or suggest <u>comparing the format of the database to a format criteria</u> and enabling a user configuration based on results of such a comparison.

   B. Durinovic-Johri fails to describe or suggest "<u>comparing the formatting characteristic against a format criteria,</u>" as recited in claim 29.

   The Final Office Action cites to a substantive comparison performed by Durinovic-Johri of received content against stored content, and wrongly suggests that this substantive comparison meets the claimed format comparison. <u>See</u> Office Action at page 5, lines 3-4. However, the portion of Durinovic-Johri referenced by the Final Office Action for this purpose (column 4, line 64 to column 5, line 5) describes a comparison of a received code against a stored code retrieved from a database, looking for an exact match between the two. <u>See</u> col. 7, lines 21-25 (illustrating an example of such a database including the stored codes). In doing so, Durinovic-Johri suggests comparison of the received content against nothing other than corresponding stored content, and does not disclose comparison of the format of the received content against the format of the corresponding stored content. Durinovic-Johri nowhere suggests access to format criteria, nor does it suggest a comparison of the formatting characteristics of data against such format criteria.

   The impact of differences between the technology described by Durinovic-Johri and the subject matter of claim 29 is perhaps best illustrated with an example. If we assume entry of 999-999-9999, Durinovic-Johri will compare some version of that numerical sequence to numbers that it maintains in its database. The presence of an exact match will inform some future action, and the absence of an exact match will inform some other future action. However, other than the presence or absence of an exact match between the numerical sequence, Durinovic-Johri does not suggest the existence of any other information to be gleaned from the received entry.

   By contrast, the subject matter of claim 29 is not limited to the existence or absence of exact matches between a received entry and stored information. Rather, that subject matter enables user configurations irrespective of the existence or absence of an exact match between a received entry and stored information. More pointedly, claim 29 recites that the format of an

Applicant : Richard Rodriquez-Val et al.   Attorney's Docket No.: 06975-179001 / Commerce 04
Serial No. : 10/032,006
Filed   : December 31, 2001
Page   : 11 of 17

entry is compared against format criteria, and action is taken based on this format comparison, without regard for whether the entry matches some database content in substance. Thus, in the example above, it is not relevant to claim 29 whether or not a database entry exists with the numerical sequence 999-999-9999. Rather, and irrespective of the existence or absence of an exact match between a received entry and stored information, if the format of 999-999-9999 matches stored format criteria, user configuration may be enabled.

While an exact match by Durinovic-Johri may imply the existence of a match between the format of entered and stored data, Durinovic-Johri clearly does not make a comparison of format. As illustrated above, Durinovic-Johri is therefore unable to determine whether to enable user configurations in the absence of a comparison of the substance of the data entered against the data stored, or in a situation where the received data that does not match the stored data has a compliant format. While neither of these particular scenarios is required by the claim, they illustrate the impact of differences between claim 29 and Durinovic-Johri.

Thus, Durinovic-Johri fails to describe or suggest "comparing the formatting characteristic against a format criteria," as recited in claim 29. Accordingly, Applicant respectfully request that the rejection of claim 29 along with its dependent claims to be reversed.

2. Claim 36.

Similar to claim 29, claim 36 recites a system in which a formatting characteristic of received data is identified and compared against a format criteria. Accordingly, Applicant respectfully requests the rejection of claim 36 to be reversed, for at least the reasons described above with respect to claim 29.

A check for $620, including the Appeal Brief fee of $500 and the Petition for Extension

of Time fee of $120 is enclosed. Please apply any other charges or credits to Deposit Account

No. 06-1050.

Respectfully submitted,

Date:___3/10/200c_____   _____

W. Karl Renner
Reg. No. 41,265

Fish & Richardson P.C.
1425 K Street, N.W.
11th Floor
Washington, DC 20005-3500
Telephone: (202) 783-5070
Facsimile: (202) 783-2331

40328483.doc

Appendix of Claims

1-22.   (Cancelled)

23.   A method for enabling a billing configuration, the method comprising:

receiving first data regarding a communications characteristic;

retrieving second data indicative of a frequency of usage related to the communications

characteristic;

retrieving third data indicative of a frequency of usage threshold;

comparing the second data to and the third data; and

based on results of the comparison between the second data and the third data, enabling a

billing configuration.

24.   The method of claim 23 wherein the first data includes data relating to a telephone

number.

25.   The method of claim 23 wherein the first data includes data indicative of a user name.

26.   The method of claim 24 wherein the second data indicates historical information

regarding past attempts to enable the user configuration based on the first data.

27.   The method of claim 26 wherein the historical information is defined over a specified

period of time.

28.   The method of claim 23 wherein the first data includes Automatic Number Identification

(ANI) data.

29.   A method for enabling a user configuration, the method comprising:

receiving data regarding a communication characteristic;

identifying a formatting characteristic of the data received;

comparing the formatting characteristic against a format criteria; and

enabling a user configuration based on results of the comparison between the formatting characteristic and the format criteria.

30.   The method of claim 29 wherein the communications characteristic includes a telephone number.

31.   The method of claim 29 wherein the formatting characteristic and the format criteria each include length.

32.   The method of claim 31 wherein the length includes a number of characters.

33.   The method of claim 29 wherein the format criteria require only numeric data in the received data.

34.   (Cancelled)

35.   A system for enabling a billing configuration comprising:
        means for receiving first data regarding a communications characteristic;
        means for retrieving second data indicative of a frequency of usage related to the communications characteristic;
        means for retrieving third data indicative of a frequency of usage threshold;
        means for comparing the second data to the third data; and
        means for enabling a billing configuration based on results of the comparison between the second data and the third data.

36.   A system for enabling a user configuration comprising:
        means for receiving data regarding a communication characteristic;
        means for identifying a formatting characteristic of the data received;
        means for comparing the formatting characteristic against a format criteria; and

means for enabling a user configuration based on results of the comparison between the formatting characteristic and the format criteria.

37-47. (Cancelled)

Evidence Appendix

No Copies required.

Related Proceedings Appendix

A copy of the decision rendered by the Pre-Appeal Board is enclosed.